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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/884,311

06/19/2001

Steven B. Adler

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12/16/2009

Walder Intellectual Property Law (END)

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EXAMINER

ARMOUCHE, HADI S

ART UNIT

PAPER NUMBER

2432

MAIL DATE

DELIVERY MODE

12/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/884,311	Applicant(s) ADLER ET AL.	
	Examiner HADI ARMOUCHE	Art Unit 2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/27/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 19 and 23-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 19 and 23-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/27/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/2009 has been entered.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract filed on 06/19/2001 of the disclosure is objected to because it exceeds 150 words (currently 158 words) and it uses: "the present invention...", "one aspect of the present invention...", "The invention also...". Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because it contains (page 8 line 15) an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 10/27/2009 was filed after the mailing date of the notice of allowance on 07/29/2009. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

6. The indicated allowability of claim 1 is withdrawn in view of the newly discovered reference(s) to King (US 7,093,286). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 27 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claims 1, 27 and 33, the phrase "may be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 33-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed towards a computer program product comprising a computer-usable medium. The specification page 7 line 29 defines the computer-usable medium as “any carrier wave, signal or transmission facility for communication”. Carrier wave and signal are non-statutory subject matter.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-2, 23-24, 27, 29-30, 33 and 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by King (US 7,093,286).

14. Regarding claims 1, 27 and 33, King teaches *an information handling system* [col 2 lines 43-46] *for handling personally identifiable information* [abstract], *said system comprising:*

a processor [col 8 line 55]; *and*

a memory coupled to the processor [col 2 lines 43-46 and col 8 line 55], wherein the memory comprises instructions which, when executed by the processor, cause the processor to:

provide a first set of object classes (network servers) representing active entities in an information- handling process [network servers: col 3 lines 15-16, col 4 lines 9-11 and figure 1 element 120] ;

provide a second object class (client devices/subscriber) representing personally identifiable information [sensitive information: col 5 lines 4-10 and col 5 lines 28-31] and associated rules in said information-handling process [client devices/subscriber: col 3 lines 15-16, col 4 lines 9-11 and figure 1 element 100] ; and

process transactions involving said personally identifiable information, using said first set of object classes and said second object class, so as to enforce a privacy policy [privacy agreement: col 3 lines 26-31 and abstract], wherein said rules define if and how said personally identifiable information may be provided, by a first data user that previously requested the personally identifiable information from an active entity that is personally identifiable by the personally identifiable information, to a second data user that requests said personally identifiable information from the first data user [col 3 lines 15-30, col 5 lines 45-49, col 6 lines 50-65, col 7 lines 24-27, and figure 1].

15. Regarding claim 2, King teaches that the *first set of object classes includes a data user object class* [network servers: col 3 lines 15-16, col 4 lines 9-11 and figure 1 element 120].

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16. Regarding claims 23, 29 and 35, King teaches that the *privacy policy is associated with the personally identifiable information and defined by said rules, and is enforced against one or more active entities represented by said first set of object classes* [col 3 lines 15-30, col 5 lines 45-49, col 6 lines 50-65, col 7 lines 24-27, and abstract], *and wherein each of the one or more active entities represented by said first set of object classes is a legal entity* [col 11 lines 40-41].

17. Regarding claims 24, 30 and 36, King teaches *a first active entity represented by a first object class in said first set of object classes is said first data user that previously requested said personally identifiable information from said data subject that is a second active entity represented by a second object class in said first set of object classes* [network servers: col 3 lines 15-16, col 4 lines 9-11, col 3 lines 15-30, col 5 lines 45-49, col 6 lines 50-65, col 7 lines 24-27 and figure 1 element 120], *and a third active entity [proxy server] represented by a third object class in said first set of object classes is said second data user that requests said personally identifiable information from said first data user* [abstract and col 3 lines 15-31].

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Tolopka et al. (US 6,044,349) referred to hereinafter by Tolopka .

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20. Regarding claim 3, King does not disclose an object class representing a filled paper form. The secondary reference Tolopka teaches a storage medium for storing personal information that is subject to access control for apportion the data among authorized entities. Figure 2 shows various types of information and options for authorizing access to different groups. The information may represent a paper filled form, see column 6, lines 36-52. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the objects in King represent paper filled forms as taught in Tolopka as a convenient manner of obtaining personal information and populating as an object, see column 6, lines 36-52.

21. Claims 19, 25-26, 28, 31-32, 34 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Gifford et al (US 5,614,927) referred to hereinafter by Gifford.

22. Regarding claims 19, 25-26, 28, 31-32, 34 and 37-38, King does not disclose transforming the personal information into a depersonalized/ anonymized format. The Gifford reference teaches protection of confidential information in a database. Column 8, lines 1-8, teaches a method where the correlation between public attributes and private attributes are reduced by camouflaging or outright removing some data to depersonalize the identifiable information based on rules. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the data in the object groups in King be depersonalized, i.e. camouflaged or removed, as taught in

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Gifford in order to protect confidential information from being inferred from a database, see column 4, lines 17-68.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HADI ARMOUCHE whose telephone number is (571)270-3618. The examiner can normally be reached on M-Th 7:30-5:00 and Fridays half day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. A./
HADI ARMOUCHE
Examiner, Art Unit 2432

/Gilberto Barron Jr./
Supervisory Patent Examiner, Art Unit 2432